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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,518	06/11/2001	Paula F. Delano	END920010011US1	4253
23550	7590	04/27/2005		
HOFFMAN WARNICK & D'ALESSANDRO, LLC 3 E-COMM SQUARE ALBANY, NY 12207			EXAMINER COLON, CATHERINE M	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 04/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,518

Applicant(s)

DELANO ET AL.

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>June 11, 2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the communication received on June 11, 2001. Claims 1-35 are now pending in this application.

Information Disclosure Statement

2. The examiner has reviewed the patents supplied in the Information Disclosure Statement (IDS) provided on June 11, 2001.

Claim Objections

3. Claim 3 is objected to because of the following informalities: The claim recites, step weighting. It appears the claim should recite, step of weighting. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 5, 6 and 16-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1 and 16, the body of the claim does not accomplish the stated objective in the preamble, which is to analyze the application needs of an entity. Additionally, claims , do not recite that the entity questions and responses are related to

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entity application needs; therefore, the analysis of the responses is not related to entity applications.

As per claims 16, 22, 26 and 31, the claims do not recite any interaction between the inventory system, which inventories entity applications and the query system, which provides a set of questions and responses related to an entity application. Therefore, it is unclear what the functional role of the inventory system is as the claims do not expressly recite the inventory system interacting with any other component within the overall system.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found

to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, method claims 1-15 merely recite the steps for analyzing application needs of an entity; however, the recited steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in person or by use of a pencil and paper and without the need of a computer or other technology.

As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention formulates questions and analyzes the responses (i.e., concrete) to provide an application recommendation to an entity (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-15 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1, 2, 4-9 and 11-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Puri (U.S. 6,064,982).

As per claim 1, Puri discloses a method for analyzing application needs of an entity, comprising the steps of:

inventorying a set of entity applications (col. 2, lines 28-36; col. 3, lines 30-31 and 54-59; Figure 2; During a product selection session performed by an entity (i.e., a customer), the system collects the application (i.e., product) data for the entity.);

formulating a set of questions related to an entity application based on a business strategy corresponding to the entity (col. 1, lines 33-35 and 50-53; col. 3, lines 24-26; col. 5, lines 13-15; Figure 4; The system takes the entity through a series of interactive questions to learn more about the application needs of the entity. The system utilizes a database.); and

receiving entity responses to the set of questions (col. 5, lines 3-8; Figures 4-6; Entity responses are received through an interactive interface.).

As per claim 2, Puri discloses the method of claim 1, further comprising the step of weighting possible responses to the set of questions based on the business strategy (col. 5, lines 3-15; Figure 4; By allowing an entity to identify needs that are important for its business, the system is in essence weighting the responses. If a particular need is identified, the system guides the entity to answer more questions relating to that need, thereby emphasizing the need.).

As per claim 4, Puri discloses the method of claim 1, further comprising the step of analyzing the received responses to make a set of recommendations (col. 6, lines 5-

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13 and 43-46; The system provides recommendations to the entity based on the application needs assessment. The application needs assessment includes an interactive tool through which the entity selects from a predetermined question/answer session.).

As per claim 5, Puri discloses the method of claim 1, further comprising the step of generating a report based on the received entity responses (Figure 9).

As per claim 6, Puri discloses the method of claim 1, wherein the entity applications are grouped by business process (item 42 in Figure 4 shows a business process grouping of the needs to be identified by the entity).

Claims 7-9 and 11-35 recite substantially similar subject matter as claims 1, 2 and 4-6 above. Therefore, claims 7-9 and 11-35 are rejected on the same basis as claims 1, 2 and 4-6.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri (U.S. 6,064,982) as applied above.

As per claim 3, Puri does not expressly disclose the method of claim 2, wherein the step of weighting responses comprises the step of assigning a value for each possible response to the set of questions. However, as discussed in claim 2, by allowing an entity to identify needs that are important for its business and then asking additional questions related to those needs, Puri is emphasizing the identified needs and thus, weighting the responses (col. 5, lines 3-15; Figure 4). Assigning a value to a weight is old and well known in the art. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to assign values to the needs identified by an entity because doing so allows the system to associate each identified need with a specific worth, providing the system with more accurate and quantifiable data with which to conduct the needs assessment, which is a goal of the Puri system (col. 6, lines 43-46).

Claim 10 recites substantially similar subject matter as claim 3 above. Therefore, claim 10 is rejected on the same basis as claim 3.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mancisidor et al. (U.S. 6,745,172) discusses an expert system with a guidance engine;

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- Paseman (U.S. 5,745,765) discusses a system and method for automatic and interactive configuration of custom products; and
- Guheen et al. (U.S. 6,519,571) discusses a dynamic customer profile management system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae (formerly, C. Michelle Colon) whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

703-872-9306 [Official Communications; including After Final
communications labeled "Box AF"]

571-273-6727 [For status inquiries, draft communication, labeled
"Proposed" or "Draft"]

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cmc

April 19, 2005


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